

II. REMARKS

The Examiner is requested to reconsider the application in view of the foregoing amendment and the following remarks.

Response to Claim Objections

As to the claim objection regarding claims 1-325, the use of the word "signal" is not improper. The Examiner appears to have confused any use of the word "signal(s)" with a claim drawn to a "signal" as a statutory class under 35 U.S.C. § 101. A computer generated signal, signals in a computer, a signal to communicate information over a communication path like a TCP/IP communications link, or signaling between devices, for example, should not elicit an objection under 1.75 or a rejected under 35 U.S.C. Sec. 101. For guidance please see MPEP 2106, 2173.05(g) and *In re Lowry*, 32 F.3d 1579, 1583-84, 32 USPQ2d 1031, 1035 (Fed. Cir. 1994). No amendments have been provided since the Applicant's use of "signal(s)" is proper. Withdrawal of the this objection is earnestly requested.

As to claim 153, Applicant appreciates the Examiner noticing this inconsistency. In response claim 153 has been amended to make clear that claim 153 is dependent upon claim 2. Withdrawal of this objection is earnestly requested.

With regard to the use of "Blue Mountain", in claim 44 and the Specification, the Applicant responds as follows. Claim 44 is amended to "Blue Mountain", removing the word "type". Blue Mountain provides a definite manner for users to composing greeting cards that include a graphical element. The use of Blue Mountain has been capitalized to distinguish it from other nouns in both the claim and specification. All reasonable efforts have been taken to respect the proprietary nature of "Blue Mountain". MPEP 608.01(v) in part states "[i]f the product to which the trademark refers is set forth in such language that its identity is clear, the examiners are authorized to permit the use of the trademark if it is distinguished from common

descriptive nouns by capitalization....Although the use of trademarks having definite meanings is permissible in patent applications, the proprietary nature of the marks should be respected. ...Every effort should be made to prevent their use in any manner which might adversely affect their validity as trademarks." Therefore, the use of Blue Mountain will be maintained in claim 44 and the Specification. Withdrawal of this objection is earnestly requested.

Response to 112 Rejections

In response to the Examiner's rejection of claims 6 and 21 under 35 U.S.C. Sec. 112 2nd paragraph, Applicant has provided amendments to address minor antecedent issues with regard to "the sheet". The amendments render the rejections moot. In response to the Examiner's concern that the claims may be missing the element of "a sheet", the Applicant would like to make clear that no elements were missing. The respective claims from which claims 6 and 21 are independently dependent upon do not include "a sheet". The recitation of "a sheet", as amended, is the first instance for their respective branch of the claim trees. Withdrawal of these rejections is earnestly requested.

The Examiner's rejection of claims 16 and 32 under 35 U.S.C. Sec. 112 2nd is improper. Claims 16 and 32 are not indefinite based upon the recitation of "wherein the step of shipping includes shipping the product in packaging displaying a network address to facilitate an electronic communication from an ordering system, including a computer, to the order center" Though claim 16 recites a "network address", claim 32 does not use this element, instead claim 32 recites a "network gateway address". The elements embodied in the phrase, "packaging displaying a network address" or "packaging displaying a network gateway address" are clearly intended to encompass a network address, claim 16, or network gateway address displayed on packaging for shipping. Either network address being displayed on the packaging can be used to communicate with the order center. See Page 19, paragraph 3, lines 18-20 of the

specification for exemplary teachings. This claim language is clear and definite. Withdrawal of the rejections of claims 16 and 32 is earnestly solicited

Response to the Double Patenting Objections

Examiner's objection to claims 34 and 120 under double patenting is improper. Claims 34 and 140 are dependent upon claim 1 and cover different aspects that are not insubstantial. Claim 34 includes elements of "receiving ordering information at the order center by telephone" in combined with "in producing the signals representing the packing list." Claim 140 does not recite elements of "in producing the signals representing the packing list." Moreover, claim 140 recites "providing a telephone for receiving ordering information as an alternative to receiving the ordering information over the Internet", which is substantially different than only "receiving ordering information at the order center by telephone" as recited in claim 34. Claims 34 and 140 cover different aspects and are not substantially duplicate claims. Withdrawal of this objection is earnestly requested.

Examiner's objection to claims 268 and 269 under double patenting is improper. Claim 268 includes the additional element directed to tracking and delivery information "for waybill shipping in accordance with the order", which claim 269 does not include. Claim 268 further limits the type of order and delivery tracking of shipping information to "waybill shipping", which is not a slight difference in wording. Claim 269 is broader in scope than claim 268, which allows for order tracking and delivery information over the Internet, which is not limited to "waybill shipping". Withdrawal of this objection is earnestly requested.

In response to the Examiner's objection to claims 41 and 84 under double patenting, claim 84 has been canceled, without prejudice

In response to the Examiner's objection to claims 42 and 85 under double patenting, claim 85 has been cancelled, without prejudice.

Response to Prior Art Rejections Under Sect. 103

The rejection of claims 1-325 is improper. Applicant respectfully submits that the Examiner has failed to establish a *prima facie* case of obviousness and has not reasonably apprised the Applicant of the propriety of continuing prosecution as provided for in MPEP 2142-2143, 2184, 35 U.S.C. Sec. 132 and Rule 104.

Pursuant to 35 U.S.C. Sec. 132, Applicant is entitled to "the reasons for such requirement ... *together with such information as may be useful in judging the propriety of continuing prosecution...*". A similar requirement is made by Rule 104(a)(2), which requires "...reasons for any... requirement... and such information or references will be given as may be useful in aiding the Applicant... to judge the propriety of continuing the prosecution. Applicant has once again been denied this entitlement, based upon the manner in which the rejection of the claims has been set forth.

In view of Sec. 132 and Rule 104, if a combination or modification is to be contended, the PTO is required to provide not only the reasons, but also *such information as may be useful in judging the propriety of continuing prosecution...*". Otherwise, the rejection is improper. The Examiner has failed to meet their obligation under Rule 1.104 and 35 U.S.C. Sec. 132.

Examiner had the initial burden of proof in presenting a *prima facie* case of unpatentability. See *In re Oetiker*, 977 F.2D 1443, 24 USPQ2d 1443, 144 (Fed. Cir. 1993), however, this burden was not been met. Looking to claim 1, for example, evidence of a reason to combine the eight separate and disparate references has not been shown, evidence that the combination does not change the operation of each individual reference has not been reasonably shown, and evidence that their combination as a jigsaw puzzle would have been common sense such that each piece would have fit together without modification was not provided; hindsight is well known to be prohibited in making an obviousness rejection. The only

nexus between the eight references used to concoct the 103 rejection, for example the rejection of claim 1, is the Applicant's own invention and claims.

Hutton ('479) was sown together with seven other references to reject claims 1-3, 5-8, 10-23, 25-37, 39-42, 49-119, 121, 125, 128, 130, 133-146, 148, 150, 152, 268-305, 307-310 under 35 U.S.C. Sec. 103, in a manner that would have made Mary Shelly proud to Frankenstein.

Taking claim 1, the Examiner's Graham v. Deere analysis starts with alleging a list of three (3) elements that Hutton teaches, lists six (6) other elements that Hutton does not teach, then alleges that those defects in Hutton would have been obvious to one of ordinary skill level by adding an aggregate of seven (7) separate and disparate references, specifically, Tackbarry ('496), Slotnick ('200), Barti ('158), Lambert ('191), Wojcik ('493), Dudle ('291) and Nicholls ('369). Examiner has not made a *prima facie* case of obviousness since their motivations are at best conclusory. The Examiner has not provided reasonable evidence, rational, or analysis as to why it would have been obvious to one of ordinary skill level in the art, at the time of the invention, would have knowingly modified Hutton with each of the seven (7) references, when put together would have reasonably resulted in the independent claims. Further the rejection fails, in a similar manner, to provide any analysis connecting together the individual teachings of each of the seven (7) separate and disparate teachings, such that it would have been obvious to one of ordinary skill to combine their individual teachings together with no change in their operation or function with Hutton to result in Applicant's independent claims. The only nexus is the Applicant's claims. See KSR International and Graham v. Deere decisions.

Claims 9 and 24 are rejected based on the prior eight (8) references in further view of Davis ('996) and Davidson ('3496), in section 20, which first calls in the motivation to combine from claim 1, and then adds more conclusory statements for motivation to add in Davis and

Davidson into the rational to meet two more elements, as recited in 9 and 24. This results in a ten reference 103 to explain away eight (8) elements.

Claim 4, is rejected rejected based on the prior eight (8) references used for claim 1, in further view of Santoiemmo (5465530), in section 21, which first calls in the motivation to combine from claim 1, and then adds more conclusory statements for motivation to add in Santoiemmo ('530) into the rational to meet one more element.

Claims 153-192, 198-287 are rejected based on the prior eight (8) references in further view of Tognazzini ('512), in section 24, which first calls in the motivation to combine from claim 1, and then adds more conclusory statements for motivation to add in Tognazzini into the rational to meet one more element.

Hutton ('479) was sown together with eight other references to reject claims 38, 43-45,47,120,122-124,126-127,129,131-132,147,149,151, 306, 311-315,317-325 under 35 U.S.C. Sec. 103, in a manner that would have made Mary Shelly proud to Frankenstein.

Taking claim 38, the Examiner's Graham v. Deere analysis starts with alleging a list of one (1) element that Hutton teaches, lists seven (7) other elements that Hutton does not teach, then alleges that those defects in Hutton would have been obvious to one of ordinary skill level by adding an aggregate of eight (8) separate and disparate references, specifically, Tackbarry ('496), Slotznick ('200), Barti ('158), Lambert ('191), Wojcik ('493), Dudle ('291), Nicholls ('369) and Tobin ('666). Examiner has not made a *prima facie* case of obviousness since their motivations are at best conclusory. The Examiner has not provided reasonable evidence, rational, or analysis as to why it would have been obvious to one of ordinary skill level in the art, at the time of the invention, would have knowingly modified Hutton with each of the eight (8) references, when put together would have reasonably resulted in the independent claims. Further the rejection fails, in a similar manner, to provide any analysis connecting together the individual teachings of each of the eight (8) separate and disparate teachings, such that it would

have been obvious to one of ordinary skill to combine their individual teachings together with no change in their operation or function with Hutton to result in Applicant's independent claims. The only nexus is the Applicant's claims. See *KSR International* and *Graham v. Deere* decisions.

Claim 46 is rejected based on the prior nine (9) references in further view *Santoiemmo* ('530), in section 22, which first calls in the motivation to combine from claim 38, and then adds more conclusory statements for motivation to add in *Santoiemmo* into mix to meet two more elements, as recited in 46.

Claims 48, 316, 193-197 are rejected based on the prior eight (9) references in further view of *Tognazzini* ('512) in section 23, which first calls in the motivation to combine from claim 122, and then adds more conclusory statements for motivation to add in *Tognazzini* ('512) into the mix to meet one more element.

Reciting from MPEP 2142, which in part states "[t]he examiner bears the initial burden of ***factually supporting*** any prima facie conclusion of obviousness. If the examiner does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness....the key to supporting any rejection under 35 U.S.C. Sec. 103 is the ***clear articulation of the reason(s) why the claimed invention would have been obvious.***" [emphasis added] The Examiner has not clearly articulated any facts supporting a determination of obviousness based upon the assertion that the combination of references would have yielded a predictable result or provide for a logical step in the art.

As is also recognized in MPEP 2142, "[t]he Supreme Court in *KSR International Co. v. Teleflex Inc.*, 127 S Ct. 1727(2007), 82 USPQ2d 1385, 1396 noted that the ***analysis supporting*** a rejection under 35 U.S.C. Sec. 103 ***should be explicit.***" [emphasis added] The Examiner has not provided an explicit analysis with facts supporting the rejections of the independent claims using 8-9 references in order to meet a lesser number of elements.

The Federal Circuit has made clear that "rejection on obviousness cannot be sustained with mere conclusory statement; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *In re Kahn*, 441 F.3d 977, 988, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006). See also KSR International, *Id.*

Rendering a conclusion of obviousness, based upon an assertion that a combination of references would have yielded predictable results or perform better or provide more options, without clearly articulating an explicit analysis factually supporting the determination of obviousness is merely conclusory. Without providing rational, supported with some evidence, the conclusion is also mere conjecture. The Examiner's Declaration or Affidavit is required to support this contention of fact.

Another defect of the Examiner's rejection is that it ignores the fact that the "no change in their respective functions" is also required to make the case of obviousness. Citing from 2143:

The rationale to support a conclusion that the claim would have been obvious is that all the claimed elements were known in the prior art and one skilled in the art could have combined the elements as claimed by known methods with ***no change in their respective functions***, and the combination yielded nothing more than predictable results to one of ordinary skill in the art. *KSR*, 550 U.S. at ___, 82 USPQ2d at 1395; *Sakraida v. AG Pro, Inc.*, 425 U.S. 273, 282, 189 USPQ 449, 453 (1976); *Anderson's-Black Rock, Inc. v. Pavement Salvage Co.*, 396 U.S. 57, 62-63, 163 USPQ 673, 675 (1969); *Great Atlantic & P. Tea Co. v. Supermarket Equipment Corp.*, 340 U.S. 147, 152, 87 USPQ 303, 306 (1950). "[I]t can be important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the elements in the way the claimed new invention does." *KSR*, 550 U.S. at ___, 82 USPQ2d at 1396. ***If any of these findings cannot be made, then this rationale cannot be used to support a conclusion that the claim would have been obvious to one of ordinary skill in the art.*** [emphasis added]

Due to the dearth of analysis and factual support in support of Examiner's conclusion of obviousness the Examiner has not shown that with the combination of references there would be "no change in their respective functions".

Looking to the rejections of the other independent claims and depend claims, the Examiner appears to repeat and recycle the same conclusory statements and same citations from the prior art to dismiss 325 claims.

The Examiner's attention is also drawn to the enclosed Board Decision of Ex Parte Eugene Howard Massey Jr.

"...given the disparity of problems addressed by the applied prior art references, and the differing solutions proposed by them, any attempt to combine them in the manner proposed by the Examiner could only come from Appellant's own disclosure...even assuming, arguendo, that proper motivation were established for the Examiner's proposed combination of references, we fail to see how and in what manner the references could be combined to arrive at the specific combination set forth in the appealed independent claims."

Though not binding precedent, the reasoning is apt in view of the foregoing combination of references contended to be combinable in the Office Action. If the Sec. 103 rejections are maintained, as per Massey, it is also the Examiner's burden under Sec. 132 and Rule 104 to provide information as to why the reasoning of Massey is not applicable in the instant case.

With respect to the present application, the Applicant hereby rescinds any disclaimer of claim scope made in the parent application or any predecessor or related application. The Examiner is advised that any previous disclaimer, if any, and the prior art that it was made to avoid, may need to be revisited. Nor should a disclaimer, if any, in the present application be read back into any predecessor or related application.

Applicant respectfully requests a personal interview.

III. CONCLUSION

The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235, and if any extension of time is needed to reply to said office action, this shall be deemed a petition therefore.

Ser. No. 09/149,650
Atty. Ref.: Proflowers-P1-98
Art Unit 3692

APPLICANT CLAIMS LARGE ENTITY STATUS. The Commissioner is hereby authorized to charge any fees associated with the above-identified patent application or credit any overcharges to Deposit Account No. 50-0235, and if any extension of time is needed to reply to said office action, this shall be deemed a petition therefore.

Please direct all communication to the undersigned at the address given below.

Respectfully submitted,



Date: April 10, 2009

Peter K. Trzyna
(Reg. No. 32,601)

P.O. Box 7131
Chicago, IL 60680-7131
(312) 240-0824